

REMARKS

In the office action dated 22 August 2007, the rejected the claims as being obvious in view of U.S. pre-grant publication 2003/0218995 (*Kim*) and U.S. patent 6,963,745 (*Singh*). The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of *Kim* to incorporate features from *Singh* to arrive at the features of claim 1.

It is respectfully submitted that the present invention is not obvious and that the Examiner is mistaken.

Kim discloses a method for handling inter-RAT cell measurement in a dual mode UE in a connector mode, which supports both GSM/GPRS and UMTS. *Singh* relates to inter system handovers in a mobile telecommunication system, these performed when a dual mode user equipment covered by both GSM/GPRS and UMTS connects a dedicated channel and sets up a call in a BSS region where the GMS/GPRS provides coverage, and then moves to a UMTS network. The combination of *Kim* and *Singh* does not render the pending claims obvious under any test of obviousness.

In the recent decision of *KSR v. Teleflex*, the U.S. Supreme Court discussed the Federal Circuit's teaching, suggestion, motivation (TSM) obviousness test but the Court essentially held that obviousness under §103 should be determined under the test set that the Court out in *Graham v. Deere*. As the Examiner knows, obviousness under *Deere* is determined by a consideration of the scope and content of the prior art; differences between the prior art and the claims at issue; and the level of ordinary skill in the pertinent art.

All that being said, the plain language of §103 requires that obviousness be determined by whether claimed subject matter, as a whole would have been obvious at the time of its invention. In *KSR*, the Court said that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." Obviousness must be determined by a consideration of the prior art "as a whole" as

well as a consideration of the claimed invention, “as a whole.” Stated another way, it is improper for an Examiner to pick and choose snippets of different references to support a rejection under §103.

Federal Circuit case law still holds that when obviousness is based on a combination of references, there must be “reasonable expectation” of the combined references’ success in achieving the claimed result and the combined references must disclose each and every pending claim limitation¹. In view of the foregoing, it was improper for the Examiner to have concluded that *Kim* and *Singh* rendered the pending claims obvious.

Claim 1 defines a method for taking measurements in a mobile telecommunications system. An example of the problem which the present application seeks to address is given in paragraph [0011] of the application as filed which states: "For instance, the RRC may change state very briefly (for instance to send a Cell Update message) and then return to the original state." In a known system a UE moving from one state to another can result in all the settings of the measurement being sent again to Layer 1, and the Layer 1 having to initialize the measurement again before any results can be taken (paragraph [0014] of the application as filed).

A clear difference between the pending claims and the prior art is that the pending claims require the detection of a state change, whereas both *Singh* and *Kim* relate to an inter network handover. In fact, the pending claims expressly recite steps that include state changes and state change detection. Thus, when the prior art references are considered as a whole, there is little reason to combine them. Even if there were reason to combine them, there is little likelihood that *Kim* and *Singh* could be successful in achieving the result achieved by the invention recited in the pending claims because neither of operate or include steps that claim 1 requires.

¹ See MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143.02 citing *In re Merck Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Another difference is that the present invention requires "maintaining the measurement settings initialized previously". The Examiner acknowledges that *Kim* fails to disclose this feature. *Singh* does not disclose the maintaining step either.

Singh discloses storing a current UMTS DCH configuration and cell application parameters. *Singh* goes on to state that these items are stored in order to allow the UE to return to a previous DCH in case the handover procedure to GSM fails (column 11, lines 9-13). It is respectfully submitted that *Singh* does not explicitly or inherently disclose maintaining measurement settings as required by the pending claims. Under controlling Federal Circuit case law, the absence of even a single pending claim limitation from a combination of cited references is by itself enough to establish that the present invention is not obvious in view of *Singh* and *Kim*.

A further difference is that neither *Singh* nor *Kim* discloses the feature of claim 1 whereby layer 1 receives a measurement control resume command and then resumes taking measurements with the maintained measurements settings. The Examiner acknowledges that *Kim* fails to disclose this feature, as he must, because the pause and resume commands are stated in paragraphs [0038] - 0040] as being proposed by the inventors, however, the Examiner asserts that the resume feature is disclosed in *Singh* at col 12 lines 26-64.

Singh discloses restoring UMTS relevant physical layers (e.g. column 12 line 33) when a handover to GSM fails. *Singh* does not disclose restoring measurement settings and does not disclose performing an action in response to a change in state of the UE.

Under controlling Federal Circuit case law, the pending claims' subject matter would not have been obvious to a person skilled in the art based on *Singh's* feature of storing DCH configuration and cell allocation parameters. Furthermore, it would not have been obvious to a person skilled in the art that a handover between cellular technology is equivalent to the claimed limitation that requires a change of state. It is submitted that because both *Singh* and *Kim* relate to inter network handovers and that because the present invention relates to the change in state of

a UE, and because not all of the pending claim limitations can be found in *Kim* and *Singh* that the Examiner's finding of obviousness was improper under controlling Federal Circuit case law and the Supreme Court's test of obviousness set forth in *Graham v. John Deere Co.*

Unless the Examiner can justify the combination of *Kim* and *Singh* as a whole, establish that their combination satisfies each and every pending claim limitation and establish that their combination had a reasonable chance of achieving the result achieved by the invention recited in the pending claims, the rejection under 35 U.S.C. §103 must be withdrawn.

Respectfully submitted,

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